REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed January 13, 2005. At the time of the Office Action, Claims 1-12 were pending in the Application. Applicant adds new Claims 13-28 to the Application. These claims do not provide any new matter and are readily supported by the corresponding Specification. Applicant also amends Claims 1, 3-5, and 7-12 without prejudice or disclaimer. The amendments to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Information Disclosure Statement (IDS)

Applicant has submitted an IDS with this Response for the Examiner's review. Applicant respectfully requests the Examiner to consider the references and to formally indicate that he has evaluated these references in the Prosecution of this case.

Claim Objections

The Examiner has made an objection to the claims. Specifically, the Examiner identified minor clerical errors. Applicant has made several amendments to the identified claims to overcome the Examiner's objection. Applicant apologizes for these oversights.

Section 112 Rejection

The Examiner rejects Claims 5 and 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Again, Applicant has made a series of amendments in order to resolve the Examiner's concerns.

Section 102 Rejection

The Examiner rejects Claims 1-4, 7-8, and 11-12 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,047,051 issued to Ginzboorg, et al. (hereinafter "*Ginzboorg*"). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.[1] In addition, "[t]he identical invention <u>must</u> be shown in as complete detail as is contained in the . . . claims" and "[t]he elements <u>must</u> be arranged as required by the claim."[2] In regard to inherency of a reference, "[t]he fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."[3] Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art.[4]

As amended, Independent Claim recites:

> A method for providing a piece of content to a subscriber terminal from a content server, wherein the provision of the content from the content server to the subscriber terminal is controlled by a proxy, and said control of the content provision comprises the following steps:
> - receiving in the proxy a content request for providing a the content,
> - determining by means of the proxy a billing address for the content,
> - providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal, and
> - generating billing information related to the content.

Using the well-settled jurisprudence cited above, *Ginzboorg* could not possibly anticipate the pending subject matter for a multitude of reasons. For example, one

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[1] *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

[2] *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

[3] MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*).

[4] MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*).

anticipate the pending subject matter for a multitude of reasons. For example, one fundamental difference between *Ginzboorg* and the pending subject matter is that a request for content is received by the proxy <u>before</u> content is retrieved from a content server. This is disparate from the teachings of *Ginzboorg*. This order of operation is critical for billing by the proxy.

Indeed, at the very passage cited by the Examiner for supporting the §102 rejection, *Ginzboorg* discloses: "The customer terminal CT, includes a service browser (which can be, for example, a Web browser), which the customer uses to find suitable services from the Internet. After finding a suitable service, which in this example is the Video-on-Demand service of service provider SP1, the customer selects the service in question (for example, a movie) by clicking the option, for example. The service selection stage is indicated by arrow A. So at this point the customer terminal and the server of the service provider communicate.

When the customer has made the selection, the server of the service provider sends to the billing server WD, (arrow B) the service identifier "Sid," identifying the movie in question, and the subscriber identifier "Cid" of the customer in question. The Cid is obtained, for example, from the customer's browser on the basis of the source address of the received messages (for example, the socket address of the TCP connection). So the browser is always required to provide the customer identity and address, at least to the billing service provider, but preferably also to the service provider." (See *Ginzboorg* at Column 5: lines 43-62.)

The timing of these billing operations is important for several reasons. First, the proxy of the present invention is able to determine how to bill this content *before* it is provided. This is not akin to the operations of *Ginzboorg*. Second, in more specific applications, this proxy configuration would allow the proxy to prohibit the delivery of certain content due to an outstanding balance of the subscriber terminal. Third, the architecture of the present invention avoids the communication of *Ginzboorg* (from a content provider to a proxy), as the restriction (or decision making) is placed on the "front end" of the request in the present invention. This would eliminate additional processing by the content server, which would (in theory) always be required to ascribe an identity for an end user requesting the information being delivered and then to send that to the proxy to be stored and processed. Using the architecture outlined by the pending claims, the content server would

not have to be modified to provide this extra communication because the proxy is configured to make content routing decisions. For at least this reason, Independent Claim 1 is patentable over *Ginzboorg*.

Another fundamental difference between *Ginzboorg* and the pending subject matter that the Examiner should appreciate is that *Ginzboorg* pertains to a service and not to content delivery. Referencing again the passage of *Ginzboorg* provided supra, it is evident that *Ginzboorg* deals with types of service (e.g. Video-On-Demand) and not specific content. Evaluating *Ginzboorg* thoroughly confirms that its architecture is confined to services being provided to the subscriber terminal. Although this distinction appears to be minor, it is truly significant. For example, in the context of *Ginzboorg*, this would correlate to a subscriber terminal being billed for a given movie (e.g. Braveheart), as opposed to the service of Video-On-Demand. *Ginzboorg* clearly does not provide for such content billing. In contrast, the architecture circumscribed by Independent Claim 1 relates to the actual content being delivered to the subscriber terminal (e.g. web pages, on-line newspapers, etc.), and not a service (e.g. enhanced QoS features, Video-On-Demand, etc.). For at least this additional reason, Independent Claim 1 is patentable over *Ginzboorg* and, furthermore, over any of the other references of record.

Section 103 Rejections

The Examiner rejects Claim 5 under 35 U.S.C. §103(a) as being unpatentable over *Ginzboorg* in view of U.S. Patent No. 5,956,391 issued to Melen, et al. (hereinafter "*Melen*"). The Examiner rejects Claim 9 under 35 U.S.C. §103(a) as being unpatentable over *Ginzboorg* in view of U.S. Patent No. 5,970,477 issued to Roden (hereinafter "*Roden*"). The Examiner rejects Claim 10 under 35 U.S.C. §103(a) as being unpatentable over *Ginzboorg* in view of U.S. Publication No. 2002/0059114 issued to Cockrill, et al. (hereinafter "*Cockrill*").

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.[5]

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. This issue has been evaluated extensively in the §102 analysis above. The *Roden-Ginzboorg* and *Cockrill-Ginzboorg* combinations are flawed in that there is simply no disclosure in any of the references of any of the operations described above (e.g. the delivery of specific content, the receipt of the content request before the request is fulfilled by the content server, etc.).

In addition, Independent Claim 12 recites a similar (but not an identical) limitation and, thus, is allowable over this combination using a similar rationale. Additionally, using analogous reasoning, the corresponding dependent claims of theses Independent Claims are also allowable over the references of record.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.
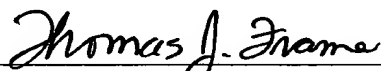
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[5] *See* M.P.E.P. §2142-43.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits a check in the amount of $400.00 to cover the fee for the additional new claims. Applicant also submits herewith a check in the amount of $120.00 to cover the cost of the One-Month Extension of Time fee and a check in the amount of $180.00 to cover the cost of the IDS filing fee. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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Date: May 12th, 2005

Customer No. 05073